

5



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,133	01/16/2001	Ernest S. Richards	909-1	3427

27758 7590 06/30/2005

MICHAEL F. PETOCK, ESQUIRE  
46 THE COMMONS AT VALLEY FORGE  
1220 VALLEY FORGE ROAD, P.O. BOX 856  
VALLEY FORGE, PA 19482

EXAMINER

ZIA, SYED

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/761,133

Applicant(s)

RICHARDS, ERNEST S.

Examiner

Syed Zia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 12 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This office action is in response to request for reconsideration filed on April 12, 2005. Original application contained Claims 1-37. Applicant did not amend any claim, Applicant added a new Claim 38. Therefore, Claims 1-38 are pending for consideration.

### ***Response to Arguments***

Applicant's arguments filed on April 12, 2005 have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 1-37 applicants argued that the cited prior art (CPA) [Fischer (EPA EP 0770 953 A2) and DeLaHueraga (U. S. Patent 6,779,024)] does not teach, "the host that utilizes a random number generator to generate a random value", and there is no disclosure of "the security device sending the public key number of the person to be identified to a host", "security device decrypting the public key number encrypted random message using person's private key number and sending the decrypted message", and also argued that cited prior art merely talks about "initial validation step... notary device in question" and "means for sending public key.. to verify the identity of the person".

This is not found persuasive. Cited prior art clearly teaches system and method for electronically verification using a smart card personal date and time notary device that performs notarized digital signature on input value using stored private key and time and date indications from internal clock. The device is fabricated on a portable medium, e.g. smart card, carried by a user. It includes an input/output port, and a secure, and tamper resistant, store for holding a private key. The key is used to perform digital signatures associated with the user. This tamper resistant secret private key storage is embodied on the chip. The private key storage is coupled to the processor which, in turn, is coupled to a permanent memory that stores the program executed by the processor. A processor coupled to the port receives a value input at the port to be digitally signed. It also receives date and time indications from at least one device clock. The processor uses the private key and the date and time indications to perform a notarized digital signature for output at the port. At least one clock is embodied on the card. A second clock and a random value generator are also preferably coupled to the processor. The device combines digital time notarization into a digital signature operation to ensure that a time stamp is always automatically present. This ensures that time stamp is automatically present by eliminating need for separate time stamping device (col.6 line 56 to col.7 line 55).

As a result, the system of cited prior art provides a system and method for an apparatus for electronic verification as broadly claimed in system.

Applicants clearly have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read

Art Unit: 2131

narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that cited prior art does teach or suggest the subject matter broadly recited in independent and dependent claims. Accordingly, rejections for Claims 1-38 are respectfully maintained.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-11, 18-33, and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (EPA EP 0770 953 A2).

2. Regarding claim 1 Fischer teaches and describes a method of electronically verifying [notarizing] that a person possessing a security device is who the person claims to be (col.1 line 35 to col.2 line 7), comprising (Fig.1):

sending a message by said security device [trusted device, such as smart card, notary decoder, smart card disk or MCIA device] associated with the person whose identity is to be verified, said message including said person's public key number (col.7 line 10 to line 22, acol.7 line 26 to line 33);

Art Unit: 2131

receiving said message by a host, said host encrypting a random message using said public key number and sending said public key number encrypted message to said security device (col.7 line 26 to line 45);

said security device decrypting said public key number encrypted random message using said person's private key number and sending said decrypted random message to said host (col.6 line 56 to col.7 line 10); and

said host comparing the decrypted random message sent by the security device with the random message previously encrypted by said host with said public key number to verify the identity of the person (col.7 line 41 to line 55).

3. Regarding claim 22 Fischer teaches and describes a apparatus for enabling electronic identification of a person, comprising:

means for permanently storing a corresponding private key number and a public key number assigned to said person (col. 3 line 32 to col. 4 line 25);

means for sending said public key number to a host seeking to verify the identity of said person (col.7 line 10 to line 22, acol.7 line 26 to line 33);

means for receiving from said host a random message encrypted with said public key number (col.7 line 26 to line 45);

means for decrypting said random message encrypted with said public key number (col.6 line 56 to col.7 line 10); and

Art Unit: 2131

means for sending said decrypted random message to said host for comparison to said random message previously encrypted with said public key number to verify the identity of said person (col.7 line 41 to line 55).

4. Regarding claim 38 Fischer teaches and describes an apparatus (Fig.1-5), comprising:

a self contained stand alone security device which contains a memory for permanently storing a public key number and a corresponding private key number, transmitter means, receiver means and decryption means (col. 3 line 32 to col. 4 line 25);

said permanent memory storing a corresponding private key number and a public key number assigned to a person to be identified by said stand alone security device (col.4 line 9 to line 25);

said transmitter means for sending said public key number to a host seeking to verify an identity of said person (col.7 line 10 to line 22, acol.7 line 26 to line 33);

receiver means for receiving from said host a random message encrypted with said public key number (col.7 line 26 to line 45);

said decryption means using used for decrypting said random message encrypted with said public key number using said private key number from said permanent memory col.6 line 56 to col.7 line 10);

said transmitter means for sending said decrypted random message to said host for comparison to said random message previously encrypted with said public key number to verify the identity of said person col.7 line 41 to line 55); and

wherein said apparatus functions as an admission control device and wherein said

Art Unit: 2131

verification of the identity of the person in accordance with the foregoing steps may be repeated throughout a period of admission (col.4 line 48 to line 54).

5. Claims 2-3, 8, 9, 18, and 19 are rejected applied as above in rejecting Claim 1.

Furthermore, Fischer teaches and describes a method to identify and verify that a party utilizing a piece of electronic equipment, such as a personal computer on the Internet, is who he or she claims to be, wherein:

As to claim 2, said security device is a computer with associated security hardware having said person's private key number programmed therein (col.4 line 1 to line 3m and col.4 line 9 to line 13).

As to claim 3, said security device is a laptop computer with associated security hardware having said person's private key number programmed therein (col.2 line 9 to line 16).

As to claim 8, said security device is a computer provided with associated security software having said person's private key number programmed therein (col.4 line 1 to line 3, and col.4 line 9 to line 25).

As to claim 9, said security device is a laptop computer provided with associated security software having said person's private key number programmed therein (col.2 line 9 to line 16, and col.8 line 54 to col.9 line 1).

As to claim 18, said host first sends a query to said security device as to its identity before said security device sends a message which includes said person's public key number (col.7 line 3 to line 10, col.8 line 5 to line 11, and col.10 line 17 to line 32).



Art Unit: 2131

As to claim 19, the method of electronically verifying is repeated during a session on which said security device is logged-on to said host (col.8 line 27 to line 40, and col.14 line 30 to line 34)

6. Claims 23, and 27-31 are rejected applied as above in rejecting Claim 22. Furthermore, Fischer teaches and describes an apparatus to identify and verify that a party utilizing a piece of electronic equipment, such as a personal computer on the Internet, is who he or she claims to be, wherein:

As to claim 23, including means at said host for generating a random message (col.4 line 34 to line 47, col.7 line 41 to line 47).

As to claim 27, said means for decrypting said random message includes use of the RSA algorithm (col.4 line 18 to line 25).

As to claim 28, said means for permanently storing is comprised of a one time programmable microprocessor (col.3 line 58 to col.4 line 3, and col.4 line 9 to line 18).

As to claim 29, said means for permanently storage comprises a read only memory (col.3 line 58 to line 59).

As to claim 30, said apparatus is contained on security hardware which communicates with a computer (col.3 line 55 to col.4 line 3, and col.4 line 9 to line 18).

As to claim 31, said computer is a laptop computer (col.2 line 9 to line 16).

As to claim 36, said apparatus is mounted on a card for use as a financial transaction card [smart card](col.3 line 49 to line 54).

Art Unit: 2131

As to claim 37, said apparatus is mounted on an identification card [such as smart card] (col.3 line 49 to line 54).

7. Claims 4-7, 10-11, and 20-21 are rejected applied as above in rejecting Claims 2, 3, and 19. Furthermore, Fischer teaches and describes a method to identify and verify that a party utilizing a piece of electronic equipment, such as a personal computer on the internet, is who he or she claims to be, wherein:

As to claim 4, said security hardware includes a one time Programmable macroprocessor (col.3 line 58 to col.4 line 3, and col.4 line 9 to line 18).

As to claim 5, said security hardware includes a one time programmable microprocessor (col.3 line 58 to col.4 line 3, and col.4 line 9 to line 18).

As to claim 6, said security hardware includes a read only memory for storing said person's private key number (col.3 line 58 to line 59).

As to claim 7, said security hardware includes a read only memory for storing said person's private key number (col.3 line 58 to line 59).

As to claim 10, said security hardware is insertable and removable in a drive of said computer (col.10 line 33 to line 43).

As to claim 11, said security hardware is insertable and removable in a drive of said laptop computer (col.3 line 49 to line 54, and col.10 line 33 to line 43).

As to claim 20, said repeated verification is invisible [executing on computer] to said person possessing said security device (col.8 line 27 to line 40, and col.14 line 30 to line 34).

Art Unit: 2131

As to claim 21, said host compartmentalizes [executed separately] data requiring a verification for each data compartment (col.14 line 35 to line 44).

8. Claims 24-26 are rejected applied as above in rejecting Claims 23, and 30. Furthermore, Fischer teaches and describes a method and apparatus to identify and verify that a party utilizing a piece of electronic equipment, such as a personal computer on the internet, is who he or she claims to be, wherein

As to claim 24, including means at said host for encrypting said random message (col.7 line 26 to line 45).

As to claim 25, said random message is a random number (col.4 line 35 to line 47).

As to claim 26, said means at said host for encrypting includes use of the RSA algorithm (col.4 line 18 to line 25).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2131

1. Claims 12-17, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (EPA EP 0770 953 A2) and further in view of DeLaHuerga (U. S. Patent 6,779,024).

2. Claims 12-17, and 34-35 are rejected applied as above in rejecting claim 1, and 22.

Furthermore, regarding Claim 12-17, and 34-35 Fischer teach and describe a method of identification and comprising, a personal identification apparatus embodied in a token device such as a smart card. The portable identification (notary) device includes an input/output port, which is coupled to a single integrated circuit chip. The I/O port is coupled to a conventional smart card reading device which in turn is coupled to a PC, laptop computer or similar devices. A tamper resistant secret private key storage is embodied on the chip. The private key storage is coupled to a processor which, in turn, is coupled to a permanent memory that stores the program executed by the processor, and a random value generator are also preferably coupled to the host processor (Fig.1, abstract, col.2 line 9 to line 26).

Although the system disclosed by Fischer shows all the features of the claimed limitation, but Fischer does not specifically disclose other forms of identification device, such as badge, car key, and other mode of connecting the identification device to host (certification node), such as wireless communication.

In an analogous art, DeLaHuerga, on the other hand disclose computing environment that relates to system and methods which provide a wireless communication options, such as radio frequency link and infrared link using badge (or car key card) to authenticate and send and receive transaction from an identification device to a host such as certifier (abstract, col9 line8 to line 57).

Therefore, It would have been obvious to one ordinary skilled in the art at the time of invention to combine the teachings of Fischer and DeLaHuerger, because DeLaHuerger's method of communication of different identification device(s) by using wireless communication would not only extend and enhance the input/output option of identification device, such as secure badges, in the system of Fischer during transmitting and receiving data from host server but will also provide other portable options to customize user identification services.

As to claim 12, said security device is a badge or identification card (DeLaHuerger: col.19 line 13 to line 30) with associated security hardware having said person's private key number programmed therein (Fischer: col.4 line 1 to line 3, and col.4 line 9 to line 25).

As to claim 13, said security device is a car key (DeLaHuerger: col.19 line 13 to line 30) with associated security hardware having said person's private key number programmed therein (Fischer: col.4 line 1 to line 3, and col.4 line 9 to line 25).

As to claim 14, said security hardware (Fischer: Fig.1) communicates with a computer by an infrared link (DeLaHuerger: col.18 line 44 to line 58).

As to claim 15, said security hardware Fischer: Fig.1) communicates with a computer by a radio frequency link (DeLaHuerger: col.18 line 44 to line 58).

As to claim 16, said security hardware Fischer: Fig.1) communicates with a laptop computer by an infrared link (DeLaHuerger: col.18 line 44 to line 58).

As to claim 17, said security hardware communicates with a laptop computer by a radio frequency link (DeLaHuerger: col.19 line 13 to line 30).

As to claim 34, said apparatus is mounted on a badge (DeLaHuerger: col.19 line 13 to line 30).

Art Unit: 2131

As to claim 35, said apparatus is mounted on a card for use as a car key (DeLaHuerga: col.19 line 13 to line 30).

3. Claims 32, and 33 are rejected applied as above in rejecting Claim 30. Furthermore, Fischer teaches and describes a method and apparatus to identify and verify that a party utilizing a piece of electronic equipment, such as a personal computer on the Internet, is who he or she claims to be, wherein:

As to claim 32, said security hardware Fischer: Fig.1) communicates with said computer by an infrared link key (DeLaHuerga: col.19 line 13 to line 30).

As to claim 33, said security hardware Fischer: Fig.1) communicates with said computer by a radio frequency link key (DeLaHuerga: col.19 line 13 to line 30).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2131


CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ  
June 27, 2005

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100